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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD B. GORELICK, STEVEN G. MADERE,
MICHAEL D. McCARTNEY, MATTHEW W. MENGERINK,
and DAVID J. WILSON

Appeal 2007-3448
Application 09/734,045
Technology Center 2100

Decided: April 15, 2008

Before LANCE LEONARD BARRY, JEAN R. HOMERE, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-4 and 7. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

1 The invention at issue on appeal automatically inserts relevant hyperlinks into a webpage. (Spec. 1.) A host on a communications network may employ several techniques to create or obtain text to display to users. Once the host has the text, it may automatically add hyperlinks thereto. (*Id.* 11-12.) For example, it may provide advertisements that link users to sponsors of the host site. As another example, webpages often include links that direct the user to other parts of a website. (*Id.* 12.)

The Appellants complain, however, that automatically inserted links have little relevance to the specific contents of the text. Such unrelated links are of little interest to users and are easily ignored. (*Id.*)

The Appellants' invention automatically inserts relevant links into text. To do so, the invention compares the contents of the text against a database containing character strings. Each of the database's character strings has an associated hyperlink that allows users to connect to other pages on the same website or other websites. For each character string of the database found in the text, the invention inserts the associated link into the text. (*Id.* 14.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A method for automatically inserting hyperlinks into a webpage containing text, the method comprising:

comparing the text to at least one character string contained in a database to identify specific character strings from the database that appear in the text, wherein each of the character strings has an associated hyperlink that is also contained in the database;

for each of the identified character strings contained in the text, inserting the associated hyperlink into the webpage;

designating a name for a product;

storing the name of the product as one of the character strings in the database; and

communicating the name of the product to a producer of the text, wherein the name of the product is designated from a plurality of names of the product that are utilized by the producer of the text.

C. REJECTION

Claims 1-4 and 7 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,092,074 ("Rodkin") and U.S. Patent No. 6,651,058 ("Sundaresan").

II. ISSUE

"Rather than reiterate the positions of the parties *in toto*, we focus on an issue therebetween." *Ex parte Kuruoglu*, No. 2007-0666, 2007 WL 2745820, at *2 (BPAI 2007). The Examiner finds, "Since Sundaresan teaches a user-defined threshold that determines the significance of the topic

(Column 7, lines 45 - 50), the invention of Sundaresan meets the limitation because the user defines a threshold thus the user produces text, making the user a 'producer of text.'" (Ans. 8.) The Appellants argue that "the other references to the word 'text' in the claim 1 have not been considered in constructing the meaning of the phrase 'producer of the text.'" (Reply Br. 7.) Therefore, the issue is whether the Appellants have shown error in the Examiner's finding that the teachings of Rodkin and Sundaresan would have suggested communicating the name of a product to the producer of text in a webpage into which hyperlinks are automatically inserted.

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims The second step in the analyses requires a comparison of the properly construed claim to the prior art." *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed.Cir. 2003) (internal citations omitted).

III. CLAIM CONSTRUCTION

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)). "When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention."

Eaton Corp. v. Rockwell Int'l Corp., 323 F.3d 1332, 1339 (Fed. Cir. 2003).

1 Here, claim 1 recites in pertinent part the following limitations: "A method for automatically inserting hyperlinks into a webpage containing text, the method comprising . . . communicating the name of the product to a producer of the text" The latter limitation "the text" relies upon and derives antecedent basis from the preamble. Considering all the limitations, therefore, the independent claim requires communicating the name of a product to the producer of text in a webpage into which hyperlinks are automatically inserted.

IV. OBVIOUSNESS ANALYSIS

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

Here, the Examiner admits, "Rodkin et al. do not explicitly teach **communicating the name of the product to a producer of the text**" (Ans. 4.) The passage of Sundaresan he cites to cure the deficiency

describes the operation of a "new terms discoverer **90** which is illustrated in FIGS. 3, 4 and 5. The new terms discoverer **90** defines the terms that need to be examined for their relevance to a target topic (or concept)." (Col. 7, ll. 35-38.) More specifically, the secondary reference includes the following disclosure.

For a given target topic and a database of HTML [i.e., HyperText Markup Language] documents discovering a relevant topic is to discover a topic whose cluster significantly overlaps with the target topic's cluster. In other words, a significant number of the relevant topic's instances belong to the target topic's cluster. The significance is determined by a user-defined threshold.

(*Id.* at 41-47.) We agree with the Examiner that the user's defining of the significance threshold may make the user a "producer of text." (Ans. 8.) The Examiner does not allege, let alone show, however, that the user who defined the threshold also produced text in the HTML documents examined by the new terms discoverer. Further, we agree with Appellants that the combined teachings of Rodkin and Sundaresan would not have taught or suggested communicating the name of a product to the producer of text in a webpage into which hyperlinks are automatically inserted. It follows that Appellants have shown that the Examiner erred in concluding that the combination of Rodkin and Sundaresan renders claims 1-4 and 7 unpatentable.

Appeal 2007-3448
Application 09/734,045

V. ORDER

For the aforementioned reasons, we reverse the rejection of claim 1 and of claims 2-4 and 7, which depend therefrom.

REVERSED

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